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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/852,611      | 05/09/2001  | Jerold Shan          | HP-10007924         | 4891             |

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P.O. Box 272400  
Fort Collins, CO 80527-2400

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| EXAMINER |
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HEWITT II, CALVIN L

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| ART UNIT | PAPER NUMBER |
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3621

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09/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/852,611

Applicant(s)

SHAN ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,6-10,13,15-35 and 37-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6-10, 13, 15-35 and 37-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

***Status of Claims***

1. Claims 1, 4, 6-10, 13, 15-35 and 37-42 have been examined.

***Response to Amendments/Arguments***

2. Applicant's claims have been amended to recite "offering promotions based on the model" (claims 1 and 10) and "... sales promotions that were offered to the shoppers" (claim 35). However, as these features are taught by the prior art of Gerace (abstract; column 5, lines 26-40), the Examiner maintains the rejection.

The Examiner also maintains the 101 rejection applied to claim 10 and the 112 Second Paragraph rejection applied to claims 6, 15, 21 and 29.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 10, 13, 15-18, and 27-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 10 is directed to a computer program stored on a computer readable medium. However, the claim, as it is written, is broad enough to read on a program listing or pseudo-code stored on a floppy or optical disk. A program listing is representative of non-functional descriptive material and a claim directed to non-functional descriptive material whether or not it is stored on a computer readable medium is non-statutory.

Claims 13, 15-18 and 27-34 are also rejected as each depends from claim 10.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6, 15, 21 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 and 15 recite "wherein the model is based on traditional logistical regression theory and based on the maximum utility theory", however, Applicant has not provided one of ordinary skill with a specific methodology for combining the two theories for producing the model.

Claim 21 recites the limitation "the shopping behavior" in line 3. There is insufficient antecedent basis for this limitation in the claim. Claim 29 is also rejected as it recites similar language.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 10, 19-25, 27-33, 35, and 37-40 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gerace, U.S. Patent No. 5,848,396.

As per claims 1, 10, 19-25, 27-33 35, and 37-40, Gerace teaches a method for targeting ads to a user comprising:

- storing customer profile information (abstract; figures 3B-D; column/line 4/56-5/15; column/line 5/54-6/40)
- storing customer web log information (abstract; figures 3F-G; column 5, lines 26-40; column/line 6/40-7/24)
- storing promotion attributes (abstract; figures 5A-D; column 5, lines 15-40)

- inputting profile, web log and promotion attributes into a model (abstract; column 2, lines 10-23 and 35-53; column 13, lines 1-26; column 15, lines 25-44; column 18, lines 10-26; column/line 18/51-19/33) for automatically targeting sales promotions to a customer (abstract; column 1, lines 5-14; column 2, lines 1-65; column 9, lines 8-30; column 13, lines 22-26; column 22, lines 53-65; column/line 26/48-27/50; column/line 28/10-29/20)
- simulating conversion of a shopper into a buyer (column 2, lines 35-53; column 13, lines 1-26; column 18, lines 10-25), varying a promotion based on the model and observing the results (column 1, lines 5-13; column 2, lines 10-23 and 35-53; column 5, lines 8-26; column 7, lines 23-38; column 18, lines 10-25) and continuously updating the model (abstract; column 2, lines 10-23 and 35-53; column 15, lines 25-44; column 18, lines 10-26; column/line 18/51-19/33)

Regarding the calculating a percentage likelihood that a customer will become a purchaser, Gerace teaches using input such as buyer purchases (column 2, lines 35-42; column 9, lines 8-15; column 13, lines 1-32) to adjust how ads are displayed to customers (column 18, lines 10-25). Therefore, as some customers

are excluded from the population of customers who are to view ads (column 18, lines 18-26) the system of Gerace necessarily calculates a percentage likelihood that one customer is more likely to make a purchase over another.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4, 6-9, 13, 15-18, 26, 34, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace, U.S. Patent No. 5,848,396.

As per claims 4, 6, 13, 15, 26, 34 and 41, Gerace teaches using a regression analysis to match advertisements to customers (abstract; column 2, lines 10-23 and 35-53; column 15, lines 25-44; column 18, lines 10-26; column/line 18/51-19/33). Regression (e.g. linear, non-linear, logarithmic) and decision modeling (e.g. utility functions) are well-known methods for analyzing data. Therefore, it would have been obvious to one of ordinary skill to use

whatever form of analysis he/she is most comfortable with and/or produces the best results (*In re Wolfe*, 116 USPQ 443, 444 (CCPA 1961)).

As per claims 7-9, 16-18, and 42, Gerace teaches using profile, web log and promotion attributes to better target ads (abstract; figures 3A-G and 5A-D; column/line 4/56-7/24). Therefore, it would have been obvious to one of ordinary skill to collect whatever customer, customer internet history, or advertisement data necessary in order to more effectively target ads to customers (*In re Wolfe*, 116 USPQ 443, 444 (CCPA 1961)).

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

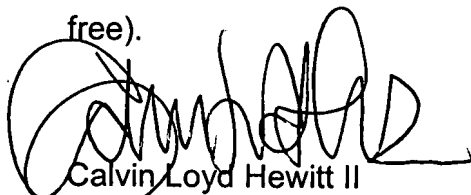


the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).  
  
Calvin Loyd Hewitt II  
Primary Examiner

September 4, 2007